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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,236	01/15/2004	James F. Woodhouse	11306-204001	5306
26191	7590	11/03/2005	EXAMINER	
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			KUHNS, SARAH LOUISE	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,236

Applicant(s)

WOODHOUSE ET AL.

Examiner

Sarah L. Kuhns

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 17-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 34-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 1-16 and 34-40 in the reply filed on September 12, 2005, is acknowledged.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dixon, U.S. Patent 6,432,461, in view of Golchert, U.S. Patent 4,024,287, and Waters, U.S. Patent 6,367,000.

In regard to claims 1-3, 5, 7 and 34-38, Dixon discloses a method printing an edible ink image on a sheet of sugar paste and then forming the sheet into a three-

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dimensional image through vacuum molding (column 3, line 56-column 6, line 41).

Golchert discloses a method of applying an image using an edible ink composition printed on a plastic sheet in which the image is transferred from the plastic sheet to the food product (column 2, lines 11-68). Waters discloses a method in which a decorated confection is formed by printing with edible ink onto an edible paper, which is placed in the bottom of a mold that is then filled with melted chocolate. Once the chocolate solidifies, the decorative sheet becomes secured to the chocolate (abstract). It therefore would have been obvious, in view of these combined teachings, to vacuum mold the sheet of Golchert in the manner taught by Dixon, in order to provide a three-dimensional decoration, and then pour a warm liquid substance into the resulting relief mold that would solidify upon cooling and adhere to the image, as taught by Waters.

In regard to claim 4, it was notoriously well known in the art to coat molds with non-stick substances and would have been obvious to do so here in order to prevent damage to the sheet and/or design.

In regard to claims 6 and 8, Dixon discloses image comprising multiple colors of the edible ink composition (see column 5, line 66-column 6, line 1).

Claims 9-16, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dixon, in view of Golchert and Waters, as applied above, in further view of Russell, U.S. Patent 6,623,553. Dixon does not disclose the edible ink composition used but it would have been expected that any known edible ink composition could be employed, such as that taught by Russell. Russell discloses an edible ink composition comprising one or more viscosity controllers, such as sucrose, at

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about 70-80% (column 3, lines 1-2), one or more film forming compounds, such as hydroxypropylmethylcellulose, at about 1% (column 4, lines 23-39), one or more emulsifiers, such as polyoxyethylene sorbitan monostearate and lecithin, at about 1-3% (column 4, lines 40-42), one or more humectants (column 3, lines 33-35), and water (column 2, line 66-column 3, line 1). Propylene glycol was known to be commonly used humectant and it therefore would have been obvious to use propylene glycol as the humectant in the edible ink composition for its art recognized use. Further, it would have been obvious to alter the film forming compound amount and include a plasticizer according to the desired moisture content and peelability. Also, powdered ink compositions were well known in the art and it would have been an obvious alternative to use the ink composition in a powdered form rather than the disclosed aqueous form.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah L. Kuhns whose telephone number is 571-272-1088. The examiner can normally be reached on Monday - Friday from 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached at 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLK


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